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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/732,791	Applicant(s) YU ET AL.	
	Examiner David Lazaro	Art Unit 2155	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 24 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-33, 35, 37, 38, 40-50, 52-60, 63 and 66-83.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).


10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.


REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


HOSAIN ALAM
 SENIOR PATENT EXAMINER


 David Lazaro
 04/18/05

Continuation Sheet

Continuation of 3.

1. NOTE: While the amendment does correct a minor informality of Claim 1, the amendment also introduces multiple informalities in regards to "non-portable" being spelled "none portable" in multiple claims (all independent claims for example). For this reason, the amendment is not deemed to place the application in better form for appeal..

Continuation of 11.

2. Applicants argue (pages 15 of remarks) - *"...the system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. Unlike the claimed e-mail provider, which transforms identification information into a transmission signal and transfers it to the user, the ISP email server is passive, i.e., it performs no transformation."*

a. Examiner's response - The examiner notes there is a difference between an "ISP email server" and an "electronic mail provider" that is claimed. The examiner interprets the "electronic mail provider" as including an email server or functional equivalent but possibly many other types of hardware and functional units. In the case of the Duphorne reference, the examiner has previously expressed the interpretation that the "local telco" provider (Col. 3 line 50 - Col. 4 line 2) is the "electronic mail provider". This "local telco" includes an email server

and other hardware/functional units to provide the service disclosed by the Duphorne reference. Such service of the "local telco" provider includes transforming identification information into a transmission signal and transferring it to the user. The examiner further notes that the claimed subject matter does not define any specific structural or hardware limitations in relation to the "electronic mail provider". Nor does the specification explicitly define the "electronic mail provider". As such, the examiner feels a broadest reasonable interpretation has been given to this claim limitation. The claim language of each of the independent claims are further composed of the transitional phrase "comprising". As such, the claims are open and do not necessarily exclude additional subject matter not explicitly claimed such as the electronic mail provider including a email server, CallerID server, or "central office".

3. Applicants argue (pages 15-16 of remarks) - *"The ISP email server 16a must receive a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in respond to the query signal...In order to obtain the claimed invention, it would have been necessary to modify the method and system of Duphorne by omitting the steps of transmitting a query signal to the remote email server and transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network."*

b. Examiner's response - The examiner does not understand how the applicants can first argue that the Duphorne reference requires the query signal(i.e. "must receive a query signal") in one instance, but then later

acknowledge Duphorne discloses that "in some embodiments, the ISP email server 16a automatically transmits the preliminary email notification signal to the central office when email addressed to the user 18 is received by the ISP email server 16a" (See last paragraph on page 16 or remarks). Obviously, as acknowledged by applicants, Duphorne does not require a query signal. Furthermore, it would seem that Duphorne has already met the requirements stated by the applicants to obtain the claimed invention as the query signal is omitted by Duphorne in certain embodiments. This will be further evidence in the remaining examiner responses.

4. Applicants argue (page 16 or remarks) - *"Although Duphorne discloses that, in some embodiments, the ISP email server 16a automatically transmits the preliminary email notification signal to the central office when email addressed to the user 18 is received by the ISP email server 16a, ... it is a preliminary email notification signal which is sent to the central office when email addressed to the user 18 is received by the ISP email server 16a, not the CallerID-compatible email notification signal. The preliminary email notification signal is then formatted into a CallerID-compatible email notification signal and transmitted to the user 18's email notification device 20 via the local loop 22. In contrast, the identification information of the claimed invention is created and transformed on the electronic mail provider and then is transferred to a non-portable receiving terminal by the same electronic mail provider. Therefore, the teaching of Duphorne is insufficient to render the claimed invention anticipating by one person with ordinary skill in the art and withdraw of the rejection is respectfully requested."*

c. Examiner's response - Again, the examiner interprets the "local telco" provider as being the "electronic mail provider" that is claimed. As such, the "local telco" provider includes the email server, the "central office" and the

CallerID server. Since the "local telco" provider includes these hardware/functional units, the identification information is created and transformed by the "electronic mail provider" and is then transferred to a non-portable receiving terminal by the same "electronic mail provider". Examiner does not find applicants arguments persuasive in this matter and asserts Duphorne's teachings are within the scope of the claimed limitations.

5. Applicants argue (Page 17 of remarks) - *"With respect to claim 20, the Examiner states that Duphorne discloses claim 20 in col. 2 lines 18-22, lines 21-35, col. 8, lines 8-41, col. 4, lines 10-31. However, the email notification signal which the system of Duphorne transmits and receives is a signal in a format compatible with existing CallerID protocols. In other word, the receiving terminal of the system of Duphorne does not need to transform the received email notification signal in a format compatible with existing CallerID protocols because it already is in a format compatible with existing CallerID protocols."*

d. Examiner's response - The examiner first notes the claim language states "transforming said transmission signal into identification information, said identification information being related to said new electronic mail that is not yet received or read by users". Nothing in the claim language states transformation of the received signal is necessarily related to a format compatible with CallerID protocols. Col. 2 lines 18-35 and col. 4 lines 10-31 generally discuss in part the transmission of the notification signal over telephone lines to receiving terminal. If a notification is converted to a transmission signal and subsequently received to be interpreted by the receiver, then "transforming" has occurred on both ends.

Specifically, transformation of the notification to be transmitted over telephone lines, and subsequently the receiving end has to be able to “transform” the transmission signal if it is going to use the signal for the intended purpose. Col. 8 lines 9-41 discloses how a received transmission signal is interpreted and identification information extracted to subsequently present the identification information of the new electronic mail. The examiner also considers this interpretation and identification to be “transforming said transmission signal into identification information.” Further support for the “transforming” of identification information is found in Col. 6 lines 44-54. This describes potential modulating formats that can be used to transmit the notification, including FSK (Frequency Shift Keying) and DTMF (Dual Tone Multi Frequency). Applicants’ specification states on page 9, “Second, the identification information data stream of the electronic mail is transformed into a transmission signal in a format, such as FSK (Frequency Shift Keying) or DTMF (Dual Tone Multi Frequency)...” (emphasis added). This explicitly states the same transforming formats used by Duphorne. Obviously if you transmit in a particular format, the receiving end will need to be able to subsequently transform that signal into the pertinent information. Therefore, Duphorne teaches “transforming said transmission signal into identification information”. Examiner does not find applicants arguments persuasive in this matter and asserts Duphorne’s teachings are within the scope of the claimed limitations.

6. Applicants argue (page 17 of remarks) - *"With respect to claim 40, the Duphorne patent does not mention a modulating means for transforming an identification information into a transmission signal. The teaching of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon and, if so, causes an associated Caller ID server of, for instance, the local telephone company to send an email notification signal in a format compatible with existing Caller ID protocols to an email notification device using a public switched telephone network. Because Duphorne sends an email notification signal in a format compatible with existing Caller ID protocols to an email notification device, there is no need of a modulating means for transforming an identification information into a transmission signal."*

e. Examiner's response - Again, applicants seem to contradict themselves in regards to the "query signal" disclosed by Duphorne. The examiner has already discussed the interpretation of the "local telco" provider and further notes that claim language of claim 40 makes no mention of an "electronic mail provider" and is much broader in scope. Furthermore, applicants provide no evidence as to why the use of CallerID protocols would necessarily exclude the use of modulating means. As stated previously, Duphorne specifically teaches modulating means for transforming the notification information into a transmission signal, particularly disclosing the formats of FSK and DTMF (Col. 6 lines 44-54). This is in accord with applicants specification on page 9 and cited in the previous response. Further evidence is in applicants' specification on pages 13-14, which further discusses the use of FSK and DTMF. Examiner does not find applicants arguments persuasive in this matter and asserts Duphorne's teachings are within the scope of the claimed limitations.

7. Applicants argue (page 18 of remarks) - *"The input terminal of Duphorne is coupled to receive the email notification signal transmitted from a Caller ID server while the receiving means of the claimed invention receives a transmission signal which is transferred from an electronic mail provider."*

8. Examiner's response - The examiner has already discussed the interpretation of the "local telco" provider as being the "electronic mail provider" and as including the CallerID server. As such, the receiving means of the receiver in Duphorne receives a transmission signal which is transferred from the "local telco" provider (the electronic mail provider). This is plainly stated in Col. 2 lines 13-35 and Col. 4 lines 10-31 of Duphorne. Examiner does not find applicants arguments persuasive in this matter and asserts Duphorne's teachings are within the scope of the claimed limitations.

9. For the remaining arguments concerning the rejection of claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 Under 35 U.S.C. 103(a), Applicants rely on similar arguments/reasoning as already given. As such, the examiner has addressed these arguments in the responses given.